REMARKS/ARGUMENTS

Claims 1-7, 9, and 11-23 are pending. Claims 1 and 9 were amended. Applicants submit that none of amendments to claim 1 raises issues of new matter.

I. *The Obviousness-Type Double Patenting Rejection Should Be Held in Abeyance*

Claims 1-8 stand provisionally rejected under the judicially-created doctrine of obviousness-type double patenting (ODP) as being unpatentable over claims 1-8 of co-pending Appl. Ser. No. 11/344,783. Claims 1-8 also stand rejected under ODP over claims 1-7 of U.S. Patent No. 7,521,544; claims 1-7 of U.S. Patent No. 7,553,942; and claims 1-5 of U.S. 7,667,011.

Applicants understand that the rejection over the '783 application is a "provisional" double patenting rejection and that the Patent Office will continue to make this rejection so long as there are conflicting claims in more than one application, unless that "provisional" double patenting rejection is the only rejection remaining in at least one of the applications. *MPEP* § 804. Applicants also understand that if a "provisional" non-statutory ODP rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. *Id.*

Since no claims in either application have yet been held allowable, Applicants respectfully ask the Patent Office to at least hold this rejection in abeyance until the claims in the instant application have been agreed to be otherwise allowable.

With regard to the rejection over the listed claims of the '544; '942; and '011 patents, Applicants respectfully submit that once the claims of the instant application are held to be otherwise allowable, Applicants will consider filing a duly executed terminal disclaimer to overcome the ODP rejection. In the meantime, Applicants respectfully request that the ODP over the listed claims of the '544; '942; and '011 patents be held in abeyance.

II. *The Rejection Under 35 U.S.C. § 103(a) Should Be Withdrawn*

Claim 1-8 stand rejected under 35 U.S.C. § 103(a) over Lidström, in view of Zeisler and Kihlberg for the reasons set forth on pages 3-6 of the Office Action. Applicants submit

that none of the references of record teach suggest or otherwise contemplate the claimed method of making ketones, using the recited triflates in combination with the claimed boronic acids.

The U.S. Supreme Court held that rigid and mandatory application of the "teaching-suggestion-motivation," or TSM, test is incompatible with its precedents. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). The Court did not, however, discard the TSM test completely; it noted that its precedents show that an invention "composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *Id.* The Court held that "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements in the way the claimed new invention does." *Id.* "To facilitate review, this analysis should be made explicit." *Id.* The obviousness rationale addressed in *KSR* was premised on combining elements known in the prior art. *Id.* at 1738-39. A parallel analysis applies to a rejection premised on the obviousness of modifying Lidström thereby arriving at the presently claimed method. In particular, the *KSR* Court noted that obviousness cannot be proven merely by showing that the elements of a claimed device were known in the prior art; it must be shown that those of ordinary skill in the art would have had some "apparent reason to combine the known elements in the fashion claimed." *Id.* at 1741.

Lidström, for example, uses aryl or alkyl iodides or vinyl triflates, in the presence of a palladium catalyst and a tin reagent, to make ketones. But, Lidström does not contemplate or otherwise suggest making ketones using the claimed triflates of the formula R_1-OTf, wherein R_1 is linear or cyclic alkyl or substituted alkyl or a heteroaryl group; **in combination with** the boronic acids having a formula $RB(OH)_2$, wherein R is linear or cyclic alkyl or substituted alkyl, aryl or substituted aryl, let alone [^{11}C]-labeled ketones. Zeisler does not remedy the deficiencies in Lidström. Zeisler uses a single **aryl** iodide, not a triflate and an arylboronic acid to make ketones. But Zeisler does not use or otherwise contemplate the claimed triflates of formula R_1-OTf. Finally, Kihlberg does not remedy the deficiencies in Lidström and Zeisler, even though Kihlberg admittedly contains a very general disclosure that suggests that [^{11}C]-labeled ketones have been made using palladium-mediated reactions. But Kihlberg is silent with regard to specific types of reagents that can be used in those

reactions. In particular, Kihlberg is completely silent with regard to the use of the claimed triflates and boronic acids as reagents to be used in the claimed method. In some, none of the references of record, even when combined, teach or otherwise suggest every limitation of the claimed method. And, there is no apparent reason why those of ordinary skill in the art would combine those elements in the fashion claimed. In sum, Applicants respectfully submit that the claimed method is not *prima facie* obvious over the combined teachings of Lidström, Zeisler, and Kihlberg. Reconsideration and withdrawal of this rejection are therefore respectfully requested.

Applicants conclude, on the basis of the above argumentation, that the pending claims are patentable and requests favorable consideration.

The Examiner is invited to telephone the undersigned in order to resolve any issues that might arise and to promote the efficient examination of the current application.

Respectfully submitted,

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